

REMARKS

The present application was filed on September 23, 2003. Prior to the present amendment, claims 1-22 remained pending, including independent claims 1, 21 and 22.

Claims 1-22 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2003/0065749 (hereinafter “Gailey”).

With regard to the §102(e) rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have chosen to amend independent claims 1, 21 and 22 so as to incorporate the limitations of dependent claim 15, which has accordingly been canceled. Because the present amendment consists solely of incorporating the limitations of a dependent claim into the independent claims, no further search should be required.

Gailey was filed on October 3, 2002 and claims priority to U.S. Provisional Application Serial No. 60/326,826, filed on October 3, 2001. MPEP §2136.03(III) specifies that the 35 U.S.C. §102(e) critical reference date “is the filing date of the provisional application with certain exceptions **if** the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.” (emphasis in original)

Applicants respectfully submit that the provisional application from which Gailey claims priority fails to support the subject matter relied upon in formulating the present rejection of dependent claim 15 in the manner required by 35 U.S.C. §112, first paragraph. Specifically, the subject matter disclosed in paragraph [0044] of Gailey, upon which the Examiner relies in formulating the present rejection of claim 15, does not appear to be present in the provisional application to which Gailey claims priority. Indeed, the provisional application at issue fails to mention any push content comprising an embedded URI, and hence clearly fails to properly support

any alleged disclosure directed to the limitations of former claim 15, and hence of independent claim 1, as amended herein

As such, Applicants respectfully submit that at least the relied-upon portion of Gailey is not entitled to a §102(e) critical reference date earlier than its filing date of October 3, 2002. Thus, the previously-filed declaration which evidenced the conception and actual reduction to practice of the claimed invention at least as early as April 19, 2002, is effective to overcome the present rejection of former dependent claim 15, and hence to render amended claim 1 patentable over Gailey.

It should be further noted that paragraph [0044] of Gailey discloses that a “user may receive a text-based message on the wireless terminal 14 that indicates the delay as well as a voice mail message or email message. The email may indicate a URL for the user to log into a website to reschedule the flight for example.” Applicants respectfully submit that the URI described in the relied-upon portion of Gailey is not included within push content described as deliverable from the server to the mobile client device, but rather is included in a separate email message. As such, even if the relied-upon portion of Gailey could be applied as prior art against the present application, Gailey would still fail to anticipate amended claim 1.

Independent claims 21 and 22 have been amended in a manner similar to that of claim 1 and are thus believed allowable for reasons similar to those identified above with regard to claim 1.

Dependent claims 2-14 and 16-20 are believed allowable at least because of their dependency from independent claim 1. One or more of these dependent claims are also believed to define separately-patentable subject matter over the cited art.

For example, claim 19 discloses a limitation wherein the push content is generated in the form of a service indication (SI) including at least one notification message and at least one corresponding URI. Applicants respectfully submit that the rejection on page 5, fourth paragraph, of the present Office Action is both substantively and procedurally deficient.

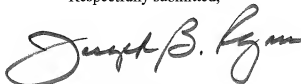
By failing to indicate the portion of Gailey relied upon in formulating the rejection of claim 19, the Examiner has failed to comply with 37 CFR 1.104(c)(2) (“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the

particular part relied on must be designated as nearly as practicable.”) Thus, in the event the present application is not considered to be in condition for allowance responsive to the remarks made herein, Applicants respectfully request that a new Office Action clearly setting forth a response to all arguments raised herein be issued and the new Office Action should be indicated as having a non-final status so that Applicants can be afforded a fair and reasonable opportunity to consider an appropriate response.

Moreover, Gailey fails to teach or suggest the limitation wherein the push content is generated in the form of a SI, much less the specific arrangement recited in claim 19 wherein the push content is generated in the form of a SI including at least one notification message and at least one corresponding URI. Rather, paragraph [0044] at Gailey discloses a technique wherein a notification message is sent via a text message and a URL is included in a separate e-mail message. Although, as indicated previously herein, this portion of Gailey is not available as prior art against the present application, this is nonetheless a teaching away from the limitation at issue.

In view of the above, Applicants believe that claims 1-14 and 16-22 are in condition for allowance, and respectfully request withdrawal of the pending §102(e) rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly distinguishable.

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